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23363 7590 06/25/2009 CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068				
EXAMINER				
SWEARINGEN, JEFFREY R				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/004,815

**Applicant(s)**

NEWNAM ET AL.

**Examiner**

Jeffrey R. Swearingen

**Art Unit**

2445

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 6, 8-19, 21-34, 46-52, 55-57, 59, 60 and 64-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-19, 21-34, 46-52, 55-57, 59, 60 and 64-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 20090520
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-3, 5, 6, 8-19, 21-35 and 46-63 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 66 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In regard to claim 66, Walker disclosed *wherein the server if configured to forward the received message along with the at least one of the ITV components over the data communications network in response to receipt of the message from the computer*. This claim cannot be reasonably interpreted by one of ordinary skill in the art. The claim is a series of incomplete sentence fragments, and includes an if statement without a result of the if statement. There is clearly a typographical error present in this newly submitted claim, but the Office cannot ascertain what the error could reasonably be. The claim is interpreted as best possible for purposes of compact prosecution.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5, 6, 8-19, 21-34, 46-52, 55-57, 59-60 and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US 6,263,505) in view of Sahota et al. (US 7,530,016).
7. In regard to claim 1, 17, 46, 49, Walker disclosed:

*receiving client software for a client to operate on a user-based hardware device that has the ability to control a display, the client software including:*

*base software for causing ITV information to be displayed on the display and including software responsive to messages from the server relating to different types of ITV interactivity, column 7, lines 33-47*

*program content applicable to a plurality of television episodes of the television program, column 4, lines 55-62 and column 4, line 27*

*episode content including ITV components applicable to a particular one of the plurality of television episodes of the television program, wherein the program content and the episode content with the ITV components are downloaded from the server to the client before the beginning of the particular television episode, the downloaded ITV components including ITV information for later display during the particular television episode, the downloaded ITV components prompting user*

*interaction in response to the display of the ITV information; column 6, line 43 – column 7, line 17*

8. Walker failed to disclose:

*generating, by a computer separate from the server and the client, a particular message associated with at least one of the downloaded ITV components of a particular television episode, the particular message including a message type identifier identifying a specific layout template for displaying the at least one of the downloaded ITV components in a specific layout format;*

*transmitting the particular message by the computer over the data communications network;*

*during the particular television episode the client receiving the particular message transmitted by the computer over the data communications network, the particular message being received separately from the at least one of the downloaded ITV components;*

*retrieving by the client the message type identifier from the received message;*

*retrieving by the client the layout template stored in the client specific to the retrieved message type identifier;*

*formatting by the client the at least one of the downloaded ITV components in the specific layout format based on the retrieved layout template; and*

*displaying by the client the at least one of the downloaded ITV components on the display in the particular layout format, wherein the message type identifier minimizes data transfer over the data communications network by avoiding transmitting with the message specific graphics data that achieves the particular layout format.*

9. Walker failed to disclose the formatting of the ITV data in a particular layout format. Walker did disclose accessing webpage data during a video program. Walker, column 7, lines 25-62.
10. Sahota disclosed using HTML to access ITV data. Sahota converted the HTML code in to a XML file for display on multiple types of platforms. The XML file is the message including a message type identifier identifying a specific layout template for displaying the at least one of the downloaded ITV components in a specific layout format. Sahota, column 5, lines 14-25.
11. Use of XML templates for formatting HTML documents for presentation in a wide variety of computers was well known to one of ordinary skill in the art at the time of invention. Walker disclosed providing ITV information from web pages. Walker suggested the web pages used HTML code (Walker, column 2, lines 2-3). Sahota illustrated that XML templates were used for formatting HTML code prior to the time of invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use the well known techniques of XML formatting for HTML code as illustrated in Sahota with the Walker interactive TV system to allow for universal presentation of the interactive content regardless of the operating system being used.

12. In regard to claim 2, 18, Walker disclosed:

*for a next episode, receiving new episode content with components related to the next episode prior to the beginning of the next episode without again receiving the program content and the base software.* Column 10, lines 1-6

13. In regard to claim 3, 19, Walker disclosed:

*for an episode of a different program, receiving a different program content and a different episode content without again receiving the base software prior to the beginning of the episode of the different program, and using the base software with the different program content and the different episode content for the episode of the different program.* Column 7, lines 48-62

14. In regard to claim 5, 21, Walker disclosed:

*ITV components include a question to which a user can respond.* Column 5, lines 24-35

15. In regard to claim 6, 22, Walker disclosed:

*the ITV components include a trivial question and a poll.* Column 5, lines 24-35

16. In regard to claim 8, Walker disclosed:

*displaying a point count for the trivia question that changes with time.*  
Column 5, lines 24-35

17. In regard to claim 9, 23, Walker disclosed:

*the base software, responsive to a user entering an answer to the trivia question, causes the answer to be provided to the server to determine if it is correct.* Column 5, lines 24-35

18. In regard to claim 10, 23, Walker disclosed:

*the base software, responsive to a user entering an answer to the trivia question, checks the answer against an answer stored as part of the episode content.* Column 5, lines 24-35

19. In regard to claim 11, 23, Walker disclosed:

*one of the client and the server corrects an answer provided to the trivia question, the client receiving from the server and displaying a point total for multiple users interacting at the same time with the server.* Column 5, lines 24-35

20. In regard to claim 12, 24, Walker disclosed:

*the client is presentation layer independent.* Column 9, lines 10-23

21. In regard to claim 13, 25, Walker disclosed:

*the client operates with a particular type of presentation software.* Column 9, lines 10-23

22. In regard to claim 14, Walker disclosed:

*the client sending messages from the user to the server and receiving messages from other users via the server in a chat functionality during the particular episode of the program.* Column 5, lines 24-35

23. In regard to claim 15, Walker disclosed:



*the episode content includes a plurality of advertisements, the base software being responsive to the particular message for causing one of the advertisements to be displayed. Column 5, lines 50-61*

24. In regard to claim 16, Walker disclosed:

*the client is responsive to the receipt of the particular message and audio or video information for synchronizing the audio or video information to the type of interactivity indicated by the particular message. Column 7, lines 48-61*

25. In regard to claim 26, Walker disclosed:

*invoking a software interface on the computer for managing the server and providing messages to and receiving messages from the server. Column 9, lines 10-23*

26. In regard to claim 27, Walker disclosed:

*the server provides messages received from users to the software interface during the episode, wherein the software interface is further invoked to transmit responses to the server for forwarding to the users. Column 9, lines 10-23*

27. In regard to claim 28, Walker disclosed:

*at least some questions for responses are transmitted by the software interface to the server, and thereafter to the users on-the-fly during the particular episode. Column 5, lines 24-61*

28. In regard to claim 29, Walker disclosed:

*the program is a television program, wherein the software interface is invoked to provide the program or episode content to the server for transmission to the users, the program or episode content being stored and timed to be received by the user in such a way that the program or episode content is synchronized to the television program to display content relevant to the program at that time.* Column 5, lines 24-61

29. In regard to claim 30, Walker disclosed:

*the program or episode content is provided to be stored in advance of being displayed and is timed to appear at selected times.* Column 9, line 41 – column 10, line 6

30. In regard to claim 31, 47, 50, Walker disclosed:

*the software interface receives supplemental content in response to a human input and provides the supplemental content on the fly as a supplement to the program or episode content provided to be stored in advance.* Column 5, lines 24-35; column 9, line 41 – column 10, line 6

31. In regard to claim 32, Walker disclosed:

*the software interface receives supplemental content in response to a human input and provides the supplemental content on the fly to appear at a desired time such that the supplemental content is relevant to the program at the desired time.* Column 5, lines 24-35

32. In regard to claim 33, Walker disclosed:

*the episode content includes a plurality of advertisements for client storage, the server sending messages to indicate to the client that the client should cause one of the stored advertisements to be displayed.* Column 5, lines 50-61

33. In regard to claim 34, Walker disclosed:

*the server provides audio or video information synchronized to textual messages to cause the textual messages to be displayed with the audio and/or video content.* Column 8, lines 6-37

34. In regard to claim 48, Walker disclosed:

*prior to receipt of any of a plurality of episodes of the video program, receiving common content related to the plurality of episodes, and prior to each episode, downloading content particular to that episode.* Column 10, lines 1-6

35. In regard to claim 51, Walker disclosed:

*at least one of the interactive components is displayed based on predetermined times during the particular episode.* Column 9, lines 41-59

36. In regard to claim 52, Walker disclosed:

*further interactive components are received and displayed on-the-fly.*  
Column 5, lines 24-61

37. In regard to claim 55, Walker disclosed:

*wherein the client software is stand-alone application.* Column 10, lines 11-12

38. In regard to claim 56, Walker disclosed:

*wherein the client software is a web-browser application.* Column 10,  
lines 1-6

39. In regard to claim 57, Walker disclosed:

*the graphics data is preloaded by the client and the base software  
retrieves the preloaded graphics data that achieves the particular layout format.  
HTML encoding.* Column 2, lines 2-3

40. In regard to claim 59, Walker disclosed:

*the message type identifier identifies the at least one of the downloaded  
ITV components triggered via the message as being one of trivia, poll, and  
advertisement.* Commercials are taught in column 5, lines 50-61. Polls and trivia  
are taught in column 5, lines 24-35.

41. In regard to claim 60, Walker disclosed:

*the one of the ITV components is dynamically selected for display during  
the particular television episode* column 7, lines 48-62

42. In regard to claims 64 and 65, Walker disclosed *the computer generates the  
message on the fly in response to input from the client.* Column 5, lines 24-61

43. In regard to claim 66, Walker disclosed *the server if configured to forward the  
received message along with the at least one of the ITV components over the data  
communications network in response to receipt of the message from the computer.*  
Column 7, lines 48-62

### **Conclusion**

44. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

45. Kitsukawa US 2002/0144288

46. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571)272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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